

REMARKS

No claims have been amended, added or cancelled in this Reply. As explained below, the Examiner did not properly respond to Applicants' previous Traversal of a Restriction requirement. Therefore, Applicants again present their argument. Accordingly, claims 40-54 are currently pending.

Restriction Requirement

In a Restriction Requirement mailed 27 May 2009; the Examiner has grouped the claims for restriction purposes as follows:

- I: Claims 40-47 and 52-53, drawn to determining whether noise is present, classified in class 370, subclass 260.
- II: Claims 48-51 and 54, drawn to determining valid speech, classified in class 379, subclass 202.01.

In the present Office Action the Examiner has not properly responded to Applicants' election with traverse. *See* M.P.E.P. § 821.01. Therefore, Applicants again present a traversal argument of this Restriction Requirement. Applicants further reserve the right to petition the Director to review this restriction requirement.

Applicants hereby elect, with traverse, to continue the prosecution of the Group I, i.e., claims 40-47 and 52-53.

Traversal of Restriction Requirement

The Examiner has asserted "the different inventions have different designs and modes of operation. Invention I is for determining noise on a port while Invention II is for determining valid speech." Restriction Requirement dated May 27, 2009 at p. 2.

Applicants assert this election/restriction requirement is improper for at least the reasons set forth below. The Examiner is reminded, "[e]very requirement to restrict has two separate aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); **and** (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween..." M.P.E.P. § 808 (emphasis added).

The Examiner simply provides the following form paragraph from the M.P.E.P., without the required explanation or reasons why there would be serious burden on the Examiner.

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Restriction Requirement dated May 27, 2009 at pp. 2-3.

The Examiner is reminded “[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a *serious burden* if restriction is not required.” M.P.E.P. § 811 (emphasis added). However, Applicants submit that no serious burden exists because the Examiner has already performed a search and issued *two* Office Actions on the merits for this Application. The claims have not been amended in any significant way since the claims were searched. The Examiner has made no effort to explain why now a serious burden would exist, whereas one did not apparently exist before. “The examiner, in order to establish reasons for insisting upon restriction, *must explain* why there would be a serious burden on the examiner if restriction is not required.” M.P.E.P. § 808.02 (emphasis added). The Examiner has not made any explanation of serious burden. Therefore, the Examiner has not met the higher burden of insisting on a restriction after a first action on the merits.

Further, M.P.E.P. § 811 also requires consideration if there will be a serious burden if restriction is not required. Applicants submit that there is no adequate showing of the serious burden. Each of the independent claims were rejected under either § 102 or § 103 in the two previous office actions. In each rejection the only element of any independent claim missing from each of two (2) different primary references was “the DTMF aspect of the present

application.” Office Action dated 10 January 2008 at p. 2 and Office Action dated 2 December 2008 at p. 2. For reference, each of these rejections is reproduced below.

Claims 46 - 51 and 53 - 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeng et al. in view of U.S. Patent No. 5,841,763 (Leondires et al.).

With respect to claims 46 - 51 and 53 - 54 Maeng et al. teach the claimed system, software and method except for the DTMF aspect of the present application. However, Leondires et al. teach such (note DTMF detection 270). It would have been obvious to one of ordinary skill in the art to have DTMF detection in order to lessen any DTMF interference to the conference.

Office Action dated 10 January 2008 at p. 2.

Claims 46 - 51 and 53 - 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabet et al. in view of U.S. Patent No. 5,841,763 (Leondires et al.).

With respect to claims 46 - 51 and 53 - 54 Tabet et al. teach the claimed system, software and method except for the DTMF aspect of the present application. However, Leondires et al. teach such (note DTMF detection 270). It would have been obvious to one of ordinary skill in the art to have DTMF detection in order to lessen any DTMF interference to the conference.

Office Action dated 2 December 2008 at p. 2.

Applicants separately argued the distinct claim sets in each response. As such, both the Examiner and Applicants have already addressed each of the stated inventions in the actions on the merits and in the responses two previous times. The alleged basis for restriction is that invention I (independent claims 40 and 52-53) is classified in class 370, subclass 260, while invention II (independent claims 48 and 54) is classified in class 379, subclass 202.01. The table below provides classification information on the references asserted in the two Office Actions.

| Reference | Asserted | Classes |
|----------------------|--|-------------------------------|
| 5,991,277 (Maeng) | Office Action (10 January 2008) 102 and Primary Current Office Action Primary | 370/263; 379/202 |
| 5,983,183 (Tabet) | Office Action (2 December 2008) 102 and Primary | 204/270; 381/1-8; 381/94.3 |

| | | |
|------------------------------|--|------------------|
| 5,841,763 (Leondires) | Office Action (10 January 2008) Secondary Office Action (2 December 2008) Secondary | 370/260; 348/15 |
| 2004/0181402 (Bartkowiak) | Current Office Action Secondary | 704/226; 704/229 |

The results above are enlightening. The primary reference asserted in the second Office Action is not listed in either of the purportedly relevant classes. The primary reference (Maeng) asserted in the current Office Action to reject the claims of Group I is actually classified in both of the classes used to separate Group I and Group II. This is an indication that the two classes are very similar and practically not distinct, undercutting the entire basis for restriction. When this similarity is compared against the serious burden requirement for a restriction after a first action, it is clear that a serious burden is not present.

Further, given that the searching is primarily done based on selected words and large numbers of subclasses are always searched (indeed, often no class is used or an entire class is used), it is submitted that the serious burden cannot be shown. A review of the various searches performed in the three Office Actions clearly shows the far reaching and not particularly class/subclass limited searching that was performed. If it was not a serious burden to perform the prior three searches, it cannot be a serious burden to perform the allegedly required search now for the same claims.

Applicants respectfully submit that the requirement to show serious burden has not been met, and cannot be met as presumably all of the inventions have previously been searched by the present Examiner **at least two times**.

Restriction after Two Rejections of Claims is Per Se Improper

Applicants further submit that per se any restriction after claims have been rejected at least two times is improper. Applicants reference the attached article¹ from Rick Neifeld, available at his firm's website as indicated in the article.

Applicants' petitions [sic] allege that the election requirements are improper because there would be no burden on the examiner since all of the

¹ Attached in Appendix to this Response.

present claims had already been rejected at least two times prior to the election requirement.

For the foregoing reasons, the examiner's provisional election requirement has been deemed to be improper.

Applicants request that the Examiner review the file wrapper in the 09/478,351 application as that application is not published and thus not available to Applicants. But the facts of the present case match the cited portions of the article and thus the petition decision, namely that the present independent claims have been rejected at least two times prior to the election requirement. Applicants submit that the decision cited above and in the article is controlling and the present restriction requirement is improper and should be withdrawn.

Prior Art Rejections

Rejections of the independent claims are discussed below. Dependent claims are not specifically discussed and are patentable at least by virtue of the fact that they include all of the limitations of their respective independent claims, including the limitations that are not taught by the cited references, as discussed below. Applicants reserve the right to specifically argue subject matter of each dependent claim in the future if necessary.

Rejections under 35 U.S.C. § 102(b)

Claims 40-43 and 52 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,991,277 to Maeng et al. ("Maeng"). Applicants respectfully traverse.²

Claims 40 and 52

The Examiner has rejected independent claims 40 and 52 with only the following information:

With respect to claims 40 – 43 and 52, note that Maeng et al. teach such limitations (see Figs 10A, 10B and 10C and Col. 9, line 38 – Col. 13, line 53).
Office Action dated 15 September 2009 at pg 2.

² Applicants submit that this use of Maeng a second time, after withdrawing Maeng in the second Office Action, is improper. The only difference between the two rejections is the change in the cited paragraphs, as the first rejection referenced all of the figures in Maeng. To reassert Maeng is clearly not the required compact prosecution, particularly in view of the admission by withdrawing the first Maeng rejection completely.

Applicants remind the Examiner that a prior art reference must teach or suggest every element of a rejected claim to form the basis of a prima facie case of anticipation under 35 U.S.C. § 102(b). In the instant rejection, the Examiner has not pointed out how the cited sections of Maeng teach or suggest each element of the rejected claims, but rather has simply pointed to sections of Maeng with no further comment. In a complex art the Examiner has a duty to explain how the prior art anticipates the rejected claims and simply pointing to all of the figures and broad sections of the cited reference, almost one half of the Detailed Description, with no additional discussion does not meet this duty. Applicants respectfully request the Examiner provide an adequate explanation of his allegations of anticipation and provide proper specific citations for each of the claim elements should the Examiner maintain this rejection, rather than having Applicants guess at the intended support, thus prolonging prosecution.

Maeng is directed to a method for determining a *talk/listen state* (i.e., determine which camera signal to make active for remote participants among a plurality of participants in a video conference) using voice detection and audio sampling. See Maeng at Abstract. Maeng discloses that “human voice detection may be incorporated into a multipoint conference system to provide a more accurate determination of whether a conference site is a talking site or a listening site... [thus] the primary transmission site is more accurately selected.” Maeng at Col. 2, lns 45-50. “Controller unit 16 then uses this talk/listen determination in order to switch video between conference sites.” Maeng at Col. 4, lns 45-46. In summary, Maeng uses audio information from the different sites participating in a multipoint conference to determine which of the multiple video sites is the primary video feed (by using human speech recognition).

In contrast to Maeng, which is directed to determining which endpoint is a speaking endpoint based on recognizing human speech, claim 40 is directed to how a summed conference audio signal is generated to broadcast to participants of the conference. In order to anticipate a claim, the cited reference must disclose each and every limitation of the claim. MPEP § 2131. Maeng cannot anticipate claim 40 at least because there is no disclosure of the following two limitations of claim 41:

- “including the received audio signal in a conference sum audio signal broadcast to at least some participants of the conference depending on the result of the comparison”

- “determining a dynamic threshold value ... if and only if ... noise was present”

Maeng does not disclose that received audio signals are optionally included or excluded from the conference audio based on a comparison. Maeng simply uses the audio characteristics to determine what site is talking and based on this determination the primary video transmission site is selected, *i.e.*, voice-activated video switching.

Furthermore, Maeng does not disclose determining a dynamic threshold value for a port if and only if noise is present at the port. In contrast Maeng teaches away from this element because Maeng teaches using a dynamic threshold level with respect to audio received from every participant, whether or not noise is detected from that participant. *See* col. 6, lines 59-64 (“A technical advantage of the present invention is the use of human voice detection along with the determination and use of a dynamic threshold level with respect to each conference site based on audio signals received from that site for use in determining whether the site is talking or listening,” *emphasis added*).

For at least these reasons Maeng cannot anticipate independent claim 40. Independent claim 52 incorporates substantially the same subject matter as claim 40 and therefore Maeng cannot anticipate independent claim 52 for at least the same reasons. Furthermore, claims 41-45 depend from and incorporate all the elements of independent claim 40 and are necessarily not anticipated for at least the same reasons as independent claim 40. Accordingly, Applicants respectfully request the Examiner withdraw this rejection.

Rejections under 35 U.S.C. § 103(a)

Claims 44-47 and 53 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Maeng in view of U.S. Patent Publication No. 2004/0181402 to Bartkowiak (“Bartkowiak”). Applicants respectfully traverse.

Claims 46 and 53

The Examiner rejects claims 44-47 and 53 with only the following information:

Maeng et al. teach the claimed limitations except for specifically reciting a noise threshold and DTMF aspects of the invention. Maeng et al. are interested in lower or

eliminating noise and Bartkowiak is also interested in lowering or eliminating noise (Note at least element 214 (noise determiner). It would have been obvious to one of ordinary skill in the art to have incorporating a noise threshold determiner as taught by Bartkowiak into the Maeng et al. as a well known means for determining an acceptable noise level on the line. With respect to the DTMF aspects of the invention note paragraphs 0032 – 000037, 0040 and 0100.

Office Action dated 15 September 2009 at pp. 2-3.

For at least the reasons stated above, Maeng fails as a primary reference in the rejection of independent claims 46 and 53. Additionally, Bartkowiak is directed to “[a]n apparatus for detecting at least one tone having a known frequency and duration in an input signal ... A signal processor determines when the input signal includes the at least one tone based on the energy threshold, the noise indicator, and the energy level.” Bartkowiak at Abstract. Bartkowiak further discloses “[a] method and apparatus to *detect tones in a noisy signal environment* using noise detection and dynamic thresholding.” Bartkowiak at ¶ 3 (emphasis added).

After review, it appears that the only mention of DTMF detection disclosed in the cited portions of Bartkowiak is that the processor unit includes a function which performs DTMF detection in a noisy environment. There does not appear to be any disclosure related to what the processor unit does with this DTMF signal.

The Examiner admits that Maeng does not teach the DTMF aspect of the present application. Next, the Examiner asserts that Bartkowiak discloses this missing element. Applicants respectfully disagree because neither Maeng nor Bartkowiak disclose “if a DTMF tone is present in the audio signal, omitting the received audio signal from a conference sum audio signal broadcast” as explicitly recited in claim 46.

For at least these reasons Maeng and Bartkowiak, either alone or in combination, fail to teach each recited element of the claimed invention and, as a consequence, the Examiner has failed to make a legitimate *prima facie* case of obviousness. Independent claim 53 incorporates substantially the same subject matter as claim 46 and is therefore patentable for at least the same reasons. Accordingly, Applicants respectfully request the Examiner withdraw these rejections and pass independent claims 46 and 53 to allowance. For at least the same reasons, claim 47

which depends from independent claim 46 is allowable over Maeng and/or Bartkowiak. Such action is respectfully requested.

Claims 48 and 54 (Subject to improper restriction requirement)

Claims, 48 and 54 are subject to an improper restriction requirement and not formally included in a rejection by the Examiner in the current Office Action. However, the following remarks address each of these claims relative to the currently cited art.

Independent claim 48 recites, among other limitations, "if valid speech is present and if no DTMF tone is present, including the received audio signal *in a conference sum audio signal* broadcast."

As discussed above, Maeng does not disclose anything about DTMF tones and Bartkowiak merely discloses detection of a DTMF signal in a noisy environment. Therefore neither Maeng nor Bartkowiak, either alone or in combination, can render claim 48 obvious. Also, independent claim 54 incorporates substantially the same subject matter as claim 48 and is therefore patentable for at least the same reasons. Thus, the Examiner has failed to make a legitimate *prima facie* case of obviousness as to either of independent claims 48 or 54. For at least the same reasons, claims 49-51 which depend from independent claim 48 are allowable over Maeng and/or Bartkowiak. Such action is respectfully requested. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections and pass all claims to allowance.

Applicants invite the Examiner to call the undersigned with respect to any questions pertaining to this Response or associated application (832/446-2445).

Respectfully submitted,

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